

### **REMARKS**

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This amendment is in response to the office action mailed April 20, 2005. Claims 1-30 were pending, claims 1, 3, 4, 6-26, were rejected and claims 2, 5, 27, 29 and 30 were objected to. Claims 1-30 have not been amended and remain in the application as originally presented.

#### **35 U.S.C. § 102(e) Rejections**

The Examiner has rejected Claims 1 and 8-11 under 35 U.S.C. § 102(e) as being unpatentable by Mok et al. (U.S. Patent No. 6,791,171) (Mok). 35 U.S.C. § 102(e) requires that:

“a person shall be entitled to a patent, unless . . . (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;”

The Mok patent discusses a method for controlling thermal generation externally to the ICs (wafer under test, item 104, figure #72, column 33, line 16) using a temperature controlled wafer chuck (306b figure #72, column 33, lines 12-19) and not a temperature generation device positioned within the integrated chip (IC). Mok further refers to an external thermal control plane provided by an external compliant wafer carrier (item 115, column 21, lines 40-45) in contact with “the back side of integrated circuits” (column 23, lines 19-28) in order to control cooling or heating through the compliant wafer carrier (item 115, column 21, lines 27-28). Mok teaches away from an internal thermal generation device by specifically teaching external thermal generation solutions.

Applicant respectfully submits that there is a patentable difference between the use of an external thermal generation device described in the Mok patent and “a temperature generation device positioned within the IC” as in claim 1. It can be seen that all of claims 1-30 are limited by a temperature generation device positioned within the IC, a substantial difference from the disclosure in the Mok patent.

As noted, Mok fails to suggest or disclose “a temperature generation device positioned within the IC” as claimed in independent claim 1. Since Mok fails to disclose this limitation, Applicant submits claim 1 is allowable for at least this reason. Claims 8-11 depend from claim 1, and thus are similarly allowable.

**35 U.S.C. § 103(a) Obviousness Rejections**

The Examiner has rejected Claims 3, 4, 6, 7, 12-26, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Mok et al. (U.S. Patent Number 6,791,171) (Mok), as applied to claims 1, 8-11 above, in view of Gold et al. (U.S. Publication Number 2003/0158697). 35 U.S.C. § 103(a) requires that:

“(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

As noted above, Mok fails to suggest or disclose “a temperature generation device positioned within the IC” as claimed in independent claim 1. Indeed, Mok teaches thermal generation external to the IC. Since Mok fails to disclose this limitation, Applicant submits claim 1 is allowable for at least this reason. Claims 3, 4, 6, and 7 depend from claim 1, and thus are similarly allowable.

As noted above, Mok fails to suggest or disclose “a temperature generation device positioned within the IC” as claimed in independent claim 11. Since Mok fails to disclose this limitation, Applicant submits claim 11 it is allowable for at least this reason. Claims 12-17 depend from claim 11, and thus are similarly allowable.

As noted above, Mok fails to suggest or disclose “a temperature generation device positioned within the IC” as claimed in independent claim 18. Since Mok fails to disclose this limitation, Applicant submits claim 18 it is allowable for at least this reason. Claims 19-23 depend from claim 18, and thus are similarly allowable.

As noted above, Mok fails to suggest or disclose “a temperature generation device positioned within the IC” as claimed in independent claim 24. Since Mok fails to disclose this

limitation, Applicant submits claim 24 it is allowable for at least this reason. Claims 25, 26 and 28 depend from claim 24, and thus are similarly allowable.

**Allowable Subject Matter**

The Examiner has objected to claims 2, 5, 27, 29 and 30 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As noted above, Applicant submits that the base claims are allowable and therefore these claims are similarly allowable.

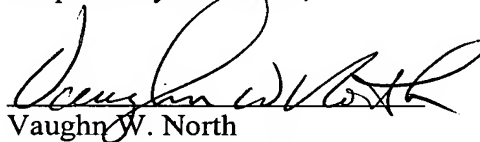
### CONCLUSION

In light of the above, Applicant respectfully submits that pending claims 1-30 are now in condition for allowance. Therefore, Applicant requests that the current rejection be withdrawn, and that the claims be allowed and passed to issue. If any impediment to the allowance of these claims remains after entry of this Amendment, the Examiner is strongly encouraged to call Vaughn North at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 08-2025.

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Respectfully submitted,



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